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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/870,199	06/05/1997	BRANFORD C. WEBB	1560B	6700
26356	7590	03/03/2009		
ALCON			EXAMINER	
IP LEGAL, TB4-8			FAY, ZOHREH A	
6201 SOUTH FREEWAY				
FORT WORTH, TX 76134			ART UNIT	PAPER NUMBER
			1612	
			MAIL DATE	DELIVERY MODE
			03/03/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRADFORD C. WEBB

Application Number: 08/870,199
Technology Center 1600

Mailed: March 3, 2009

Before Lynn M. Kryza, *Deputy Chief Trial Administrator.*

ORDER RETURNING UNDOCKETED APPEAL

This reissue application was electronically received by the Board of Patent Appeals and Interferences on January 7, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

EXAMINER'S ANSWER

GROUNDS OF REJECTION TO BE REVIEWED UPON APPEAL

A review of the file finds that the grounds of rejection to be reviewed on appeal of the claims as provided in the Examiner's Answer mailed August 13, 2008 under the heading "Grounds of rejection to be Reviewed on Appeal" is either unclear or is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection to be reviewed on appeal as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Furthermore, the examiner must provide a clear statement of whether examiner agrees or disagrees with the statement of grounds of rejection to be reviewed as set forth in the brief and an explanation of any disagreement. *See also Manual of Patent Examining Procedure (MPEP) § 1207.02 (8th ed. Rev. 6, Sept 2007)* for details.

A review of the Examiner's Answer finds that it is unclear what rejected claims are on appeal as compared to the Appeal Brief and/or the Examiner's Answer does not clearly address differences between rejections set forth in the Examiner's Answer and those addressed in the brief and the last office action. The grounds of rejection on appeal should be consistent with the grounds of rejection of record in the action appealed from, specifically, the final rejection of April 19, 2007, including any advisory action responsive to any after-final submissions. It is noted that the record reveals that the after-final amendment of August 24, 2007 has been entered, but the advisory action of September 28, 2007 does not appear to withdraw

any of the grounds of rejection set forth in the final Office action. Therefore, there appears to be a discrepancy between the rejections in the examiner's answer and the rejections in the final rejection. Specifically, the Final Rejection appears to reject claims 27-30 under 35 U.S.C. § 112, first paragraph (see Final Rejection of April 19, 2007, p. 4). The Appellant listed claims 27-30 as being rejected under 35 U.S.C. § 112, first paragraph, (see Appeal Brief filed June 5, 1997, p. 5). The Examiner's Answer stated that appellant's statement of the grounds of rejection to be reviewed on appeal was correct, (see Examiner's Answer mailed Aug. 13, 2008, p. 2). However, the Examiner's Answer does not include claims 27-30 under the heading Grounds of Rejection¹, nor does it indicate that the rejection of claims 27-30 is withdrawn.

Clarification of the record is required for all Grounds of rejection to be reviewed on appeal for all claims.

Note that the examiner appears to maintain a rejection of claims 1-56 under 35 U.S.C. § 251 on the basis that the original reissue declaration is defective. A review of the record reveals that reissue applicant filed a supplemental reissue declaration on December 22, 2006. It is unclear from the record as to whether or not this supplemental declaration has been entered and considered. Clarification of the record as to whether or not this supplemental reissue declaration of December 22, 2006 has been entered and considered is required.

¹ Though the heading is absent from the Examiner's Answer, it appears to have been omitted from the top of page 3.

Accordingly, it is ORDERED that the reissue application be returned to the Examiner:

- 1) to vacate the Examiner's Answer mailed August 13, 2008;
- 2) to generate a new Examiner's Answer clearly setting forth the correct Grounds of rejection to be reviewed on appeal consistent with the final rejection of April 19, 2007, and to correct other sections of the Answer as may be appropriate;
- 3) to clarify the record as to whether or not the supplemental reissue declaration of December 22, 2006, has been entered and considered;
- 4) to include the approval of the TC Director or his/her designee (as required for any new grounds of rejection); and
- 5) for such further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797

LMK/ack

For Patent Owner:

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